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09/585,129

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Scott T. Hughes

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WESTERN DIGITAL TECHNOLOGIES, INC.

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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/585,129	Applicant(s) HUGHES ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the amendments to the claims and remarks filed on 07 January 2010 (“2010 Jan Response”).
2. Claims 1-3, 5-8, and 10 are currently pending and have been examined.
3. This Office Action is given Paper No. 20100406. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC §112, Second Paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 5-8, and 10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claim 1

6. Claim 1 recites “...the pre-determined conditions related to advertisement distribution...” Claim 1 is indefinite because this phrase lacks antecedent basis. Particularly, it is unclear whether this phrase is referring to the previously recited “preference data,” “identification data,” or to some other data indicative of “pre-determined conditions.”

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7. Claim 6 recites the same limitation and is rejected for the same reasoning as claim 1 above.

8. The Examiner finds that because the examined claims are rejected as being indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though the claims are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §103

9. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 5, 6, and 10, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Abgrall (U.S. 6,373,498 B1), in view of Dedrick (U.S. 5,717,923 A).

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Regarding Claim 1

11. Abgrall discloses:

collecting identification data (“server **22**” collects system profile information from “profile manager” running on user computer – c. 9, ll. 25+; see also c. 5, ll. 1+ for discussion of hardware and software information that is collected identifying the various components of the user computer; see also c. 4, ll. 15-18 for exemplary information (*i.e.*, driver types)) from a network of personal computers (user computer **40_I** through user computer **40_N**; see also network 164 of fig. 2), wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment (“content that was previously downloaded... is then displayed, prior to loading and/or execution of the operating system” – c. 3, l. 54 – c. 4, l. 31; see also c. 9, l. 25+);

receiving preference data from the personal computers (“server **22**” receives preference data from “profile manager” running on user computer – c. 9, ll. 25+), wherein the preference data is selected by the user of the personal computer (user selects preference data, *e.g.* “hobbies”: “The user is then prompted to enter registration information including demographic information such as age, gender, hobbies, etc.” – c. 8, ll. 49-51);

selecting the advertisement content that is to be distributed to the personal computers based upon the received preference data from the personal computers and the pre-determined conditions related to advertisement distribution (“server **22**” analyzes preferences and selects targeted content (*e.g.*, advertisements) to be sent to the user computer based on preferences – c. 9, ll. 25+);

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formatting the advertising content for storage and display in the personal computers while or before bootloading a user selected application environment (see fig. 6 with associated text for example of advertising content being formatted for display; also Abgrall's advertisements come from the server **22** in a format that can be stored (see description of "**88b**"), hence "formatting" to achieve the storing is *necessarily present* – otherwise Abgrall's user computer's would not be able to store the advertisements received from the server); and

distributing, using the collected identification data, the formatted advertising content to the personal computers ("[c]ontent is then transmitted to user computer system's based on the user profile data..." – c. 9, ll. 25+).

12. Abgrall does not directly disclose receiving the advertising content from an advertiser.

13. Dedrick teaches receiving advertising content from an advertiser (advertiser formats and sends advertisements to metering server (*i.e.*, metering server receives ads from advertiser) – c. 4, ll. 45-55).

14. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the server of Abgrall to receive advertisements from an advertiser, as taught by Dedrick, in order to preserve advertisement creation as a responsibility of the advertiser.

15. Additionally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the server of Abgrall the receiving function as taught by Dedrick's metering server since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

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separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 5

16. The combination of Abgrall and Dedrick discloses the limitations of claim 1, as shown above. Dedrick also teaches associating a fee with data representative of the advertiser; and storing the fee in a storage device (see fig. 3 with associated text).

Regarding Claims 6 and 10

17. The Examiner has determined that claims 6 and 10 are not patentably distinct from claims 1 and 5 (*i.e.*, claims 6 and 10 are of substantially the same subject matter as claims 1 and 5). Accordingly, claims 6 and 10 are rejected in substantially the same manner as claims 1 and 5. If, in response to this action, Applicants disagree that the claims are not patentably distinct, and provide evidence that they are not of substantially the same subject matter, the Examiner may withdraw this rejection under §103 and alternatively impose a restriction requirement.

18. Claims 2, 3, 7, and 8, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Abgrall and Dedrick, in view of Merriman et al. (U.S. 5,948,061 A) (“Merriman”).

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Regarding Claims 2 and 3

19. The combination of Abgrall and Dedrick discloses the limitations of claim 1, as shown above. Abgrall and Dedrick do not directly disclose wherein the identification data comprises a unique identifier that is associated with one of the personal computers; or wherein the identification data comprises an internet protocol address.

20. Merriman teaches wherein identification data comprises a unique identifier (“IP Address”) that is associated with one of a plurality of personal computers; and wherein the identification data comprises an internet protocol address (“IP Address”) (“the user is a computer on an IP Network” and “users” – see c. 3, l. 24 – c. 4, l. 55).

21. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the identification data of Abgrall to include the IP address, as taught by Merriman, in order to accurately deliver the advertisements to the correct user.

Regarding Claims 7 and 8

22. The Examiner has determined that claims 7 and 8 are not patentably distinct from claims 2 and 3 (*i.e.*, claims 7 and 8 are of substantially the same subject matter as claims 2 and 3).

Accordingly, claims 7 and 8 are rejected in substantially the same manner as claims 2 and 3. If, in response to this action, Applicants disagree that the claims are not patentably distinct, and provide evidence that they are not of substantially the same subject matter, the Examiner may withdraw this rejection under §103 and alternatively impose a restriction requirement.

Claim Interpretation

23. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

associate “4 : to bring together or into relationship in any of various intangible ways (as in memory or imagination).” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986;

bootstrap loader “n. A program that is automatically run when a computer is switched on (booted). After first performing a few basic hardware tests, the bootstrap loader loads and passes control to a larger loader program, which typically then loads the operating system. The bootstrap loader typically resides in the computer’s read-only memory (ROM).” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997;

boot loader “n. See bootstrap loader.” Id.;

client “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997;

¹ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

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collect “1. To bring together in a group or mass; gather.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;

computer “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997;

data “Plural of the Latin datum, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997;

for “1 a — used as a function word to indicate purpose <a grant ~ studying medicine>” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997;

identifier “The name, address, label, or distinguishing index of an object in a computer program.” IEEE Standard Computer Dictionary, The Institute of Electrical and Electronics Engineers, New York, NY, 1990;

information “2 a . . . (3): FACTS, DATA” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997;

module “1. In programming, a collection of routines and data structures that performs a particular task or implements a particular abstract data type.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997;

network “(3) (A) (software) An interconnected or interrelated group of nodes.” IEEE 100 The Authoritative Dictionary of IEEE Standards Terms, 7th Edition, IEEE, Inc., New York, NY, Dec. 2000;

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node “n. 1. A junction of some type.” Computer Dictionary, 5th Edition, Microsoft Press, Redmond, WA, 2002;

server “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997;

system “n. Any collection of component elements that work together to perform a task. Examples are a hardware system consisting of a microprocessor, its allied chips and circuitry, input and output devices, and peripheral devices; an operating system consisting of a set of programs and data files; or a database management system used to process specific kinds of information.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

to “2a -- used as a function word to indicate purpose, intention, tendency, result, or end.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

35 U.S.C. §101

24. Because a server computer must be a machine, the rejections under §101 are withdrawn.

Prior Art

25. Applicants’ arguments with respect to the examined claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

26. Applicants' amendments filed in the 2010 Jan Response necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

27. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, first paragraph written description and enablement, §112, second paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

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28. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

29. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892). All references listed on form PTO-892 are cited in their entirety.

30. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/

Patent Examiner, Art Unit 3621

April 9, 2010

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621